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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,650	11/28/2000	William D. Huse	06271.0024.DVUS01	5769

22930 7590 10/19/2005
HOWREY LLP
C/O IP DOCKETING DEPARTMENT
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EXAMINER

KETTER, JAMES S

ART UNIT PAPER NUMBER

1636

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,650

Applicant(s)

HUSE ET AL.

Examiner

James S. Ketter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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In view of the appeal brief filed on 12 November 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 09/726,646. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because an obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). The MPEP states, at ¶804, that

[t]he specification can always be used as a dictionary to learn the meaning of a term in the patent claim. In re Boylan, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in Vogel recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined."

The instant claim in each instance is more narrowly drawn than the patented claim. However, the portion of the copending application that supports each of the instant claims teaches each of the narrower limitations of the instant claims. The instant claims are limited to catalytic antibodies, recited as being a "V_H and V_L polypeptide". (It should be noted that at claims 28 and 29, it is made clear that Fabs and whole antibodies are also encompassed by this term.) Again, however, the portion of the specification of the patent which supports copending claim 10 teaches V_H and V_L polypeptides, at numerous places, as well as catalytic antibodies, e.g., at page 15, lines 14-27, and as such, the invention of the instant claims is not patentably distinct from that of copending claim 10.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 22-29 stand rejected under 35 U.S.C. 102(e) as being anticipated by Iverson et al. (A'), for reasons of record set forth in Papers Nos. 18 and 22, mailed 11 February 2003 and 10 September 2003, respectively.

In the Appeal Brief filed 12 November 2004, Applicants argue that “the claim elements not being considered by the Examiner relate specifically to the process limitations in the product-by-process claims at issue”, and, quoting *United States Filter Corp. vs. Ionics Inc.*, 55 USPQ2d 1071, 1077 (D.Mass. 1999), “(‘If a prior art reference lacks any claimed element, then as a matter of law, a decision maker (whether in the Patent Office or in a Court) cannot find any anticipation.) Indeed, this principal of law is in accordance with the findings of many courts that in order to infringe a product-by- process claim, the alleged infringer must practice the claimed process and that a similar or the same product made by a different process does not infringe a product-by-process claim. See, e.g., *Atlantic Thermoplastics Co., Inc. v. Faytex Corp.*, 970 F.2d

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834, 846 (Fed. Cir. 1992). (Thus, process terms in product-by-process claims serve as limitations in determining infringement.’)” However, Applicants are directed to MPEP § 2113, wherein it is clear that, for ex parte prosecution, at least, “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, quoting *In re Thorpe*, 777, 227 USPQ 964,966 (Fed. Cir.1985). Applicants, again, point out process step limitations in the instant claims as features that distinguish over the prior art. However, products encompassed by the instant claims are regenerations of products known in the art, e.g., antibody molecules. Applicants still have not shown how the recited process steps produce, in the claimed products, any structural features in the claimed products that distinguish over the prior art. Indeed, it would seem that the purpose of the disclosed method would be to create antibody molecules that are composed of heavy and light chains copied from those found in nature.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-29 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for reasons of record set forth in Papers Nos. 18 and 22, mailed 11 February 2003 and 10 September 2003, respectively.

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At the paragraph bridging pages 13 and 14 of the appeal brief filed 12 November 2004, Applicants argue that the receptor molecules were described in terms of their structural and functional features. However, while the general structures of such receptors were known in the art, the precise function of a receptor is defined by its binding specificity. Since the art had a rather incomplete knowledge of structure-function relationships with respect to polypeptides and proteins, one of skill would not have been able to connect binding specificity, i.e., function, to structure, i.e., amino acid sequence, a priori. At pages 14 and 15, Applicants point to their listing in the specification of a number of members of a numbers of receptor families, pointing out conserved features in them. However, it is precisely the variability in regions of the contemplated receptors that is of interest to one practicing the instant invention, and it is also this variability that renders inadequate the written description as provided.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-29 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record set forth in Papers Nos. 7 and 13, mailed 21 November 2001 and 17 June 2003, respectively.

At the appeal brief filed 12 November 2004, Applicants offer an extended explanation as to what the intended meaning of the language in question is. However, it is maintained that the claims as drafted are not clear, i.e., how can a "polypeptide", clearly claimed in the singular,

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simultaneously be two polypeptides, particularly unlinked polypeptides? The language of the claim needs to be clear by itself. There is no amount of explanation on the record that can overcome a rejection under the instant statute for a self-inconsistent claim.

Any inquiry concerning this communication or earlier communications from the Examiner with respect to the examination on the merits should be directed to James Ketter whose telephone number is (571) 272-0770. The Examiner normally can be reached on M-F (9:00-6:30), with alternate Fridays off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Remy Yucel, can be reached at (571) 272-0781.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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Jsk
October 12, 2005



JAMES KETTER
PRIMARY EXAMINER